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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/627,908	07/25/2003	Jiande Chen	79109 (6328)	3453

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FITCH EVEN TABIN AND FLANNERY  
120 SOUTH LA SALLE STREET  
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CHICAGO, IL 60603-3406

EXAMINER
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KAHELIN, MICHAEL WILLIAM

ART UNIT	PAPER NUMBER
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3762

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/15/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

# Office Action Summary

Application No.

10/627,908

Applicant(s)

CHEN, JIANDE

Examiner

Michael Kahelin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 02 November 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |                                                                                      |                                                                   |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____                                                          | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Response to Arguments*

1. Applicant's arguments filed 11/2/2006 have been fully considered but they are not persuasive. In regards to the rejection of claims 1-19 under 35 USC 112(1), Applicant argued that the phrase "consisting essentially of" has support in the originally filed application because of several examples of where stimulation to the small intestine is disclosed and a positive recitation of stimulation to other organs is absent. As stated in the previous Office Action, the mere absence of a positive recitation is not basis for an exclusion. In fact, the only reference to stimulation of other organs that Examiner was able to find is on page 9, line 6 of Applicant's disclosure: "The present methods can also be used in combination with electrostimulation of other parts of the gastrointestinal tract". As there is no explicit or implicit indication in any embodiments of Applicant's invention that *require* stimulation of *only* the small intestines, the rejection under 35 USC 112(1) stands.

2. In regards to Examiner's interpretation of "consisting essentially of" as equivalent to "comprising" based on the cited passage of the MPEP, Applicant argued that the specification clearly indicates that exclusive stimulation of the small intestine is the "basic and novel feature". However, as explained above, Examiner maintains the position that the exclusive small intestinal stimulation is not clearly disclosed because the only mention of stimulation of other areas discloses stimulation in combination with

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the small intestine. As such, "consisting essentially of" is being interpreted as "comprising".

3. In regards to the anticipatory rejection of claims 1-6 and 11-17, Applicant apparently mischaracterized a phrase of the previous Office Action on page 8 of "Remarks": "Even Examiner has recognized...that providing stimulation only to the small intestines is 'unanticipated by Chen et al.'". The excerpt cited by Applicant was taken from a paraphrase of Applicant's arguments, not an admission by the Examiner. The original sentence follows: "Applicant further argued that this limitation requires that stimulation is to the small intestine only, which is unanticipated by Chen et al.", i.e., Applicant argued that the stimulation is unanticipated by Chen.

4. Applicant further argued that Chen does not anticipate the claimed subject matter because Chen only discloses small intestinal stimulation to treat rapid small bowel transit or "dumping", not obesity. As indicated in the previous Office Action, slowing transit in the small intestine will inherently slow stomach emptying, thus treating obesity. This is because the digestive tract is a closed system. Food leaves the stomach through the small intestine, and if passage through the small intestine is slowed, stomach emptying is necessarily slowed. As a further note, Chen is not required to expressly disclose that the method would treat obesity if this result would inherently occur from the disclosed method, i.e., slowing small intestinal transit. Examiner takes the position that this slowed transit will slow stomach emptying, thusly treating obesity.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1-19 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The limitation "consisting essentially of" is lacking support in the cited Examples 1 and 2. Although the examples do not positively recite stimulation of other organs, the examples also do not exclude stimulation of other organs.

Any negative limitation or exclusionary proviso must have basis in the original disclosure. The mere absence of a positive recitation is not basis for an exclusion. Any claim containing a negative limitation which does not have basis in the original disclosure should be rejected under 35 USC 112, first paragraph, as failing to comply with the written description requirement (See MPEP 2173.05(i)).

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-6 and 11-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Chen et al. (5,690,691).

9. In regards to claims 1 and 11, Chen et al. disclose multiple implantable devices comprising leads (70'-87') with connectors for attachment to a pulse generator (18, 20, and 22), wherein the leads are adjacent to the small intestine and provide electrical stimulation to slow stomach emptying (Fig. 5, elements 74-81).

10. In regards to claims 2, 12, and 13, electrical stimulation is provided to the duodenum (74) and the jejunum (77).

11. In regards to claims 3-6 and 14-17, the electrical stimulation provided is in the range of 2 to 15 pulses per minute (col. 9, line 29), about 0.1 to about 4 seconds (col. 9, line 36), and has a pause of 3-30 seconds between pulses (inherent of a frequency of 9-12.5 pulses per minute and duration of 0.1 sec.).

### ***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 7-10, 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen et al. in view of Mintchev et al. (6,449,511). Chen et al.

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disclose the essential features of the claimed invention except for pulses comprising micro-bursts within the frequency range of 5 to 100 Hz. Mintchev et al. teach of a gastrointestinal stimulator which applies electrical stimulation in bursts in the frequency range of 5-500 Hz (col. 19, line 15) to produce local circumferential contractions without causing any significant damage to the tissues (col. 19, line 51). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Chen et al.'s invention by providing stimulation in bursts of 5 to 100 Hz to produce local circumferential contractions without causing any significant damage to the tissues.

### ***Conclusion***

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Kahelin whose telephone number is (571) 272-8688. The examiner can normally be reached on M-F, 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Angela Sykes can be reached on (571) 272-4955. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MWK

*MWK*  
3/9/07

*GEORGE R. EVANS*  
PRIMARY EXAMINER  
3/12/07